

Application No. 10/580,097
Paper Dated: October 24, 2008
In Reply to USPTO Correspondence of September 24, 2008
Attorney Docket No. 5204-061409

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/580,097 Confirmation No. 7484
Applicant : PATRICK DESMOND CUNNINGHAM et al.
Filed : May 19, 2006
Title : METHOD FOR SOLUBILIZING METAL OXIDES BY SURFACE TREATMENT, SURFACE TREATED METAL OXIDE SOLUTIONS AND METHOD FOR SEPARATING METAL OXIDES
Group Art Unit : 1793
Examiner : Patricia L. Hailey
Customer No. : 28289

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

Applicants hereby respond to the Office Action dated September 24, 2008 in connection with the above-identified application.

The Office Action has requested election and restriction between the following groups:

I hereby certify that this correspondence is being electronically submitted to the United States Patent and Trademark Office on October 24, 2008.	
10/24/2008	Signature
Date	Lisa R. McNany
Typed Name of Person Signing Certificate	

Application No. 10/580,097

Paper Dated: October 24, 2008

In Reply to USPTO Correspondence of September 24, 2008

Attorney Docket No. 5204-061409

- Group I: Claims 1-21, directed to a soluble metal oxide;
- Group II: Claims 34 and 36, directed to a metal oxide solution;
- Group III: Claims 22-33 and 35, directed to a method for the preparation of a soluble metal oxide;
- Group IV: Claims 37-42, directed to a metal oxide film and uses thereof;
- Group V: Claims 43-47, directed to a process for modifying the solubility of a soluble metal oxide; and
- Group VI: Claims 48 and 49, directed to a process for the extraction of tin from a mixed tin, antimony, and iron ore.

In the Office Action, it was asserted that the inventions listed as Groups I-VI do not relate to a single general inventive concept because they lack the same or corresponding special technical feature since claim 1 is allegedly anticipated by or obvious over United States Pat. No. 6,008,285 to Kasemann et al.

Applicants hereby elect to prosecute the claims of Group I (claims 1-21) and reserve the right to file a divisional application or take such other appropriate measure as they deem necessary to protect any inventions lying within the unelected groups.

Applicants make this election with traverse. Applicants respectfully disagree that claim 1 is anticipated by or obvious over Kasemann et al. Kasemann et al. does not anticipate or render obvious claim 1 because Boehmite, as disclosed and discussed by Kasemann et al., does not form a soluble metal oxide as defined in the claims. Boehmite is not itself a metal oxide within the meaning of the claims. Consequently, the rationale prompting the restriction set forth in the Office Action is without merit.

Applicants further traverse the restriction of Groups I through VI on the grounds that a search directed toward all of the pending claims would not pose an undue burden. It is noted that all of these claims were examined in the same international application, with respect to which the subject application represents the national stage.

In view of the foregoing, withdrawal of the restriction requirement between Groups I through VI is respectfully requested. However, in the event the restriction is upheld,

Application No. 10/580,097
Paper Dated: October 24, 2008
In Reply to USPTO Correspondence of September 24, 2008
Attorney Docket No. 5204-061409

Applicants elect for prosecution on the merits the claims of Group I (claims 1-21). Applicants expressly reserve the right to file a divisional application or take such other appropriate measures as they deem necessary to protect the inventions lying within any unelected group.

Respectfully submitted,

THE WEBB LAW FIRM

By 

Kirk M. Miles
Registration No. 37,891
Attorney for Applicants
436 Seventh Avenue
700 Koppers Building
Pittsburgh, PA 15219
Telephone: (412) 471-8815
Facsimile: (412) 471-4094
E-mail: webblaw@webblaw.com